



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,921	05/06/2002	Graham Paul Luscombe	2544/112	5860

2101 7590 07/18/2003

BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

EXAMINER

HABTE, KAHSAY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/019,921

Applicant(s)

LUSCOMBE ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1624

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = pyrimidinyl or quinazolinyl (Note that the quinazolinyl ring is attached is attached to the benzodioxan moiety via the pyrimidinyl not thru the phenyl).

Group II, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = pyrazinyl.

Group III, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = pyridyl.

Group IV, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = benzofuryl.

Group V, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = benzodioxanyl.

Group VI, claim(s) claims 1-22 (in part), drawn to benzodioxan compounds (A = B = O) and T = phenyl.

Group VII, claim(s) claims 1-8 (in part), 11(in part), and 20-22 (in part), drawn to others (e.g. benzodioxan compounds and T = aromatic group with one or more N atoms that don't fall in groups I-VII; A or B = CH₂ with T = pyrimidinyl; A or B = CH₂ with T = pyridinyl; A=B = CH₂ with T = aromatic group with one or more N atoms that don't fall in groups I-VII, etc.).

2. The inventions listed as Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

Art Unit: 1624

corresponding special technical features for the following reasons: the special technical features of Groups I-VIII are different one from the other. For example, the special technical feature of Group I is pyrimidine (six-membered ring with 2 nitrogens at 1,3-position) or quinazoline ring (pyrimidine fused to phenyl) that is not present in the special technical feature of Groups II-VII. The special technical feature of Group II is pyrazinyl (six-membered ring with 2 nitrogens at 1,4-position) ring and is different from the special technical feature of other Groups. Each substituent T on the benzodioxan ring has a special technical feature that is different from the special technical features of the other groups. The nature of the heteroatoms, size of the ring, and nature of the ring, etc. constitute a special technical feature.

In addition, applicants are required to elect a single disclosed species. Note that if applicants elect Group VII, further restriction may be required.

3. A telephone call was made to Ms. Harriet Strimpel on July 16, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicants requested a written restriction requirement.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Kahsay Habte, Ph. D.
Examiner
Art Unit 1624


Mukund J. Shah
Supervisory Patent Examiner
Art Unit 1624

KH
July 17, 2003